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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,722	02/05/2001	Gordon Michael Wiram	57111-5098	6086
48276	7590	01/26/2006	EXAMINER	
TIFFANY & BOSCO CAMELBACK ESPLANADE II, THIRD FLOOR 2525 EAST CAMELBACK ROAD PHOENIX, AZ 85016			MCALLISTER, STEVEN B	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/777,722	WIRAM, GORDON MICHAEL	
	Examiner Steven B. McAllister	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 October 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-52 is/are pending in the application.
 - 4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-29 and 31-52 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/6/2005 has been entered.

Claim Objections

It is noted that claims 6, 7, 16, 17, 23 and 24 recite only information included in reports, and are drafted so as to recited elements of the apparatus. Although the elements are not interpreted as limitations to the apparatus, they will be treated as such below in order to further prosecution.

Response to Amendment

The declaration under 37 CFR 1.132 filed 1/13/2005 and presently reconsidered is insufficient to overcome the rejection of claims 1-52 based upon the U-Haul system prior to 5/2000, the well known prior art, and the Budget rental system, as set forth in the last Office action because:

The legal opinions presented in the affidavit (e.g., that the claimed invention is novel and non-obvious) are considered, but are found to have little evidentiary value since they are the opinions of an individual with an interest in the claimed invention.

It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

Regarding the alleged long standing problem, the declaration has not provided evidence of how long the problem has been felt or when it was first detected.

Regarding statements made of "my understanding" or "upon information and belief", these statements do not provide significant evidentiary value since they appear to provide only a hearsay statement of information, and not first hand objective facts or evidence.

Regarding the statements of commercial success of paragraph 18, the declaration only alleges that providing up to date information via the internet has provided a commercial advantage over its competitors, but has provided no evidence or facts to support this statement.

Regarding the statements of commercial success of paragraph 19, the declaration only alleges that reducing capital costs for computers has, but has provided no evidence or facts to support this statement.

Regarding the statements of commercial success of paragraph 20, the declaration alleges that the ability to enforce discounted contracts has saved \$6-9 million, but it is not clear that this savings has a nexus with the claimed invention, i.e., that it is due to the connection of and communication via the internet. For instance, procedural changes could also have been made (e.g., manually noting on the contract that the discounted rate is only good when returning the vehicle to a certain location, and that it is otherwise to be charged at a different rate), and it appears that the advantage could have been gained merely by changing procedures.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 32-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 32-41 are rejected because they fail to meet the requirements of 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 32-41 recite functional elements that are not disclosed as being resident in the server, but rather only in the system as a whole in the original specification and claims. The specification did not describe the invention in such a way as to reasonably convey to one of ordinary skill in the art that the inventory had possession of the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-20, and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U-Haul reservation system prior to 2/5/2000 in view of Francisco et al (5,875,433)

Prior to 2/5/2000, a PC based Point of Sale system was in use by U-Haul and certain U-Haul dealers. The system was implemented on personal computers and/or computer networks. The system comprised software (inherently embedded on a tangible medium) to provide a number of system software features. This PC-based system included a rental feature having a customer information section and a payment

section, a reservation feature having a customer information section and an equipment information section, and a payment section, having a cash section, check section and credit card section. The PC-based system further included a transfer feature having an equipment information section, a reporting feature comprising a closing report, a reservation report, an inventory report, an equipment due report and a refund report, as well as a marketing section having a marketing message relating to the moving equipment rental business. In addition, the Pc-based system included a customer information section that stored and recalled customer information, as well as an equipment information section that stored and recalled information pertaining to a transaction. It also included a rental feature with a printable rental agreement.

The system of U-Haul was not operatively connected to the internet so as to be capable of communicating. Francisco shows connecting a point of sale system to the internet via a server. It would have been obvious to one of ordinary skill in the art to modify the apparatus of Uhaul by connecting the POS system to the internet in order to provide for automated tax reporting to the relevant tax authority.

As to claims 6, 7, 23 and 24, U-Haul in view of Francisco et al show all elements except that the closing report shows a contract number, method of payment, amount received and an amount refunded for all transactions for a specified day. However, the examiner takes official notice that it is notoriously old and well known in the art to include such information on a closing report. It would have been obvious to one of ordinary skill in the art to do so in order to fully characterize the transactions occurring during that day.

As to claim 14, U-Haul in view of Francisco et al show all elements except displaying a rental rate. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of U-Haul by having it display the rental rate for equipment in order to provide the customer with information needed in making a rental decision.

As to claims 16 and 17, U-Haul in view of Francisco et al show all elements except the rental agreement including the rental terms of the transaction and an itemized list of charges. However, the examiner takes official notice that it is notoriously old and well known in the art to provide this information on a rental agreement. It would have been obvious to one of ordinary skill in the art to provide this information in order to avoid later conflicts and to provide the customer with notice of the terms of the agreement.

Claims 4 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U-Haul in view of Francisco et al as applied to claims 2 and 19 above, and further in view of the Budget reservation system.

Uhaul in view of the well known art shows all elements except the return feature. The system of Budget shows this feature. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of U-Haul by using the rental return feature of Budget in order to facilitate easy recall of data and return of equipment.

Claims 31, 32, and 34-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U-Haul reservation system prior to 2/5/2000.

Prior to 2/5/2000, a PC based Point of Sale system was in use by U-Haul and certain U-Haul dealers. The system was implemented on personal computers and/or computer networks. This PC-based system included a rental feature having a customer information section and a payment section, a reservation feature having a customer information section and an equipment information section, and a payment section, having a cash section, check section and credit card section. The PC-based system further included a transfer feature having an equipment information section, a reporting feature comprising a closing report, a reservation report, an inventory report, an equipment due report and a refund report, as well as a marketing section having a marketing message relating to the moving equipment rental business. In addition, the PC-based system included a customer information section that stored and recalled customer information, as well as an equipment information section that stored and recalled information pertaining to a transaction. It also included a rental feature with a printable rental agreement.

The system of U-Haul does not show that these software features are part of a server. However, the examiner takes official notice that it is notoriously old and well known in the art to port a standalone software package to a server for use in a client – server architecture (for example several stand alone income tax preparation programs have been placed on servers and made available via the internet). It would have been

obvious to one of ordinary skill in the art to modify the apparatus of U-Haul by placing the functionalities on a server in order to ease software updates to the system.

As to claims 35 and 36, U-Haul in shows all elements except that the closing report shows a contract number, method of payment, amount received and an amount refunded for all transactions for a specified day. However, the examiner takes official notice that it is notoriously old and well known in the art to include such information on a closing report. It would have been obvious to one of ordinary skill in the art to do so in order to fully characterize the transactions occurring during that day.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over U-Haul as applied to claim 31 above, and further in view of the Budget reservation system.

Uhaul shows all elements except the return feature. The system of Budget shows this feature. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of U-Haul by using the rental return feature of Budget in order to facilitate easy recall of data and return of equipment.

It is noted that claim 42 is interpreted as reciting a client browser having the functionalities of the rental feature and the payment section (i.e., reciting a “fat” client).

Claims 42, 43, and 45-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U-Haul reservation system prior to 2/5/2000.

Prior to 2/5/2000, a PC based Point of Sale system was in use by U-Haul and certain U-Haul dealers. The system was implemented on personal computers and/or computer networks. This PC-based system included a rental feature having a customer information section and a payment section, a reservation feature having a customer information section and an equipment information section, and a payment section, having a cash section, check section and credit card section. The PC-based system further included a transfer feature having an equipment information section, a reporting feature comprising a closing report, a reservation report, an inventory report, an equipment due report and a refund report, as well as a marketing section having a marketing message relating to the moving equipment rental business. In addition, the PC-based system included a customer information section that stored and recalled customer information, as well as an equipment information section that stored and recalled information pertaining to a transaction. It also included a rental feature with a printable rental agreement.

The system of U-Haul does not show that these software features are resident in the client browser. However, the examiner takes official notice that it is notoriously old and well known in the art to provide the software functionalities associated with a standalone system in a "fat" client having a browser interface. It would have been obvious to one of ordinary skill in the art to do so in order to facilitate access to remote shared databases while minimizing the load on the server.

As to claims 46 and 47, U-Haul in shows all elements except that the closing report shows a contract number, method of payment, amount received and an amount

refunded for all transactions for a specified day. However, the examiner takes official notice that it is notoriously old and well known in the art to include such information on a closing report. It would have been obvious to one of ordinary skill in the art to do so in order to fully characterize the transactions occurring during that day.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over U-Haul as applied to claim 42 above, and further in view of the Budget reservation system. Uhaul shows all elements except the return feature. The system of Budget shows this feature. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of U-Haul by using the rental return feature of Budget in order to facilitate easy recall of data and return of equipment.

Response to Arguments

Applicant's arguments filed 1/6/2005 have been fully considered but they are not persuasive.

Regarding claims 32-41, the arguments were not found persuasive because the examiner was unable to find support for the claimed elements residing on the server in the original specification, drawings or claims. (It is noted that the examiner's copy of the specification does not have paragraph number, and the examiner would be grateful if the applicant could translate paragraph 0043 to a page and line number.)

As to the declaration, please see the discussion regarding its reconsideration above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (571) 272-6785. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven B. McAllister
Primary Examiner
Art Unit 3627



Steven B. McAllister

STEVE B. MCALLISTER
PRIMARY EXAMINER